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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,669	11/08/2005	Hesson Chung	4698-0109PUS1	9231
2292 7590 01/10/2011 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER PALENIK, JEFFREY T				
ART UNIT		PAPER NUMBER		
1615				
NOTIFICATION DATE		DELIVERY MODE		
01/10/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/521,669

Applicant(s)

CHUNG ET AL.

Examiner

Jeffrey T. Palenik

Art Unit

1615

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 December 2010 FAILS TO PLACE THIS APPLICATION IN COMPLIANCE FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(g).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 16 and 78-90
Claim(s) withdrawn from consideration: 28

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Robert A. Wax/
Supervisory Patent Examiner, Art Unit 1615

Continuation of 11, does NOT place the application in condition for allowance because: Applicants' arguments with regard to the rejection of claims 16 and 78-90 under 35 USC 103(a) as being unpatentable over the combined teachings of Muller et al. and Woo et al. have been fully considered but they are not persuasive.

Applicants "strongly request" reconsideration of the art made of record on the grounds of the definition of the term "emulsion". Specifically, Applicants assert that since an emulsion necessitates the presence of both oily and aqueous phases that the composition of the art necessarily represents a teaching away from the instant invention. Applicants reference [0036] of Muller. It is further asserted "that the problem of solubility of paclitaxel could not be solved with the oily composition" and that the "present invention solves the same problem with a composition without changing the oily phase itself".

In response, the Examiner respectfully disagrees and maintains that Muller provides clear teaching that the paclitaxel solid particles are dissolved in either the oily or aqueous phases of the prepared microemulsion [0036]. One of the compositional variants taught by the reference teaches is the preparation of an oil-in-water emulsion wherein the drug can be dissolved in the oily phase and then further dispersed in an aqueous phase. Given this, it follows that an oily composition have paclitaxel dissolved therein is formed. That is, regardless of the location of the final oil/drug composition, be it alone or dispersed in water, the instantly claimed oil/drug composition is taught.

Regarding Applicants' "consisting essentially of" transitional language, the Examiner has reconsidered Applicants' instant disclosure and can find no immediate discussion suggesting that the presence of water alters anything concerning the instant composition. As such, said "consisting essentially of" language is interpreted by the Examiner as having the scope of "comprising" where it pertains to additional components such as water or aqueous environments. Further support of this position is found in the instant disclosure where Applicants discuss the intended target of the instant composition as being an aqueous environment. Lastly, Applicants' attempts to distinguish the instant composition over the art are unpersuasive in light of claims 80, 86, 87 and 90 which are directed to a composition including an emulsifier. Thus, it appears that the instantly claimed composition is envisioned by Applicants as taking on an emulsion form. See also Example 1 (pg. 19 of the Spec.).

For these reasons, Applicants' arguments are found unpersuasive. Said rejection is therefore maintained.